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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/791,996	03/03/2004	Carmen Flosbach	FA1013 US DIV	4286
23906	7590	10/03/2005	EXAMINER	
E I DU PONT DE NEMOURS AND COMPANY			TSOY, ELENA	
LEGAL PATENT RECORDS CENTER			ART UNIT	
BARLEY MILL PLAZA 25/1128			PAPER NUMBER	
4417 LANCASTER PIKE			1762	
WILMINGTON, DE 19805			DATE MAILED: 10/03/2005	

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/791,996	Applicant(s) FLOSBACH ET AL.	
	Examiner Elena Tsoy	Art Unit 1762	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 September 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 11,12,16 and 18-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 11,12,16 and 18-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 9/12/2005 has been entered.

Response to Amendment

Amendment filed on 9/12/2005 has been entered. Claims 13-15, and 17 have been cancelled. Claims 11-12, 16, 18-21 are pending in the application.

Specification

1. Objection to the specification as failing to provide proper antecedent basis for the claimed subject matter has been withdrawn to the cancellation of the claim 17.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 11-12, 16, 18-21 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Duecoffre et al (US 6,063,448) for the reasons of record as set forth in Paragraph No. 6 of the Office Action mailed on August 3, 2004.

5. Claims 11, 12, 16, 18-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Miyabayashi et al (US 4,880,890) in view of Miki et al (US 5397638).

Miyabayashi et al are applied here for the same reasons as set forth in Paragraph No. 7 of the Office Action mailed on August 3, 2004. Miyabayashi et al further disclose that a thermosetting resin composition may be used for preparing precoated metals (See column 6, lines 47-50) by applying the resin composition to a metal substrate such as alloyed zinc-plated steel (See column 6, lines 54) after conventional chromating pre-treatment (See column 6, lines 59). The film obtained by curing the thermosetting resin composition is completely free of yellowing and thermal degradation. The film also exhibits increased hardness as well as high flexibility, stain resistance and chemical resistance and can be utilized for, among others, electrical appliances (See column 7, lines 22-31).

Miyabayashi et al fail to teach that the method is suitable for treating automotive body.

Miki et al teach that increasing requirements for more corrosion resistance than before in automotive bodies and household electric appliances are met by coating zinc alloy-plated steel

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sheets with a chromate layer and resin film (See column 1, lines 10-29). In other words, Miki et al is a secondary reference, which is relied upon to show that a method suitable for treating household electric appliances is also suitable for treating automotive bodies.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have used the method of Miyabayashi et al for treating automotive bodies with the expectation of providing the desired high flexibility, stain resistance and chemical resistance because Miki et al is a secondary reference, which is relied upon to show that a method suitable for treating household electric appliances is also suitable for treating automotive bodies.

6. Rejection of claim 17 under 35 U.S.C. 103(a) as being unpatentable over Duecoffre et al (US 6,063,448) in view of JP 08239458 (Abstract) has been withdrawn to the cancellation of the claim 17.

7. Rejection of claim 17 under 35 U.S.C. 103(a) as being unpatentable over Miyabayashi et al (US 4,880,890) in view of JP 08239458 (Abstract) has been withdrawn to the cancellation of the claim 17.

Response to Arguments

8. Applicants' arguments filed 9/12/2005 have been fully considered but they are not persuasive.

(A) Applicants argue that a hydroxyl-functional binder of Duecoffre is based on a hybrid polymer system of methacrylic copolymer and a hydroxy-functional polyester. Further, the methacrylic copolymer is prepared in the presence of the polyester polyol. The hybrid polymers used in Duecoffre are different from a simple physical mixture of a methacrylic copolymer and polyester polyol, as seen in the present invention. The Examiner suggests that the polyester described in Duecoffre is similar to the polyester polyol (a) of the present invention.

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However, Duecoffre's clear coat does not contain a polyester polyol, but instead contains a hybrid binder comprising polyester polyol as one part, and the methacrylic acid as the second part.

The Examiner respectfully disagrees with this argument. First of all, Duecoffre clearly teaches all components of claimed invention including B) separately from A) (See column 1, lines 41-60). Secondly, Duecoffre's clear coat does contain 80 wt % -60 wt % or less of a polyester polyol (a) of present invention, **in addition** to a hybrid binder comprising e.g. **at least** 20 wt % -40 wt % polyester polyol as one part in which the second part (i.e. the (meth)acrylic copolymer portion) has been prepared by free-radical polymerization (See Abstract; column 1, lines 61-67; column 2, lines 23-36). Moreover, claims 11 and 12 do not recite negative limitation about a hybrid binder, i.e. the hybrid binder is not excluded from the composition of claims 11 and 12. See Tables and Example 5 and 6. Example 5 describes a simple physical mixture of a hybrid binder A of Example 3 **and** polyester polyol B of Example 1. Example 6 describes a simple physical mixture of a hybrid binder A of Example 4 **and** polyester polyol B of Example 1.

(B) Applicants argue that although Duecoffre teaches that 0 to 40 wt% of dihydric alcohols of molecular weight range 62 to 2000 Da, and 0 to 60 wt% of monocarboxylic acid of molecular range 112 to 600 Da are used for preparing polyester polyols (See col. 14, lines 40-65), it neither gives a specific example that is within a claimed range of 0 to 20% of monocarboxylic acid component (corresponding to element (a2) in Claims 11 and 12), nor does it give a specific example that is within a claimed range of 0 to 20% of a diol (corresponding to element (a1) in Claims 11 and 12), as claimed by the present invention. According to MPEP 2131.03 (II)-Anticipation of Ranges, "When the **prior art** discloses a **range** which. . .**overlaps**. . . **the claimed range**, but no specific examples falling within the claimed range are disclosed, a case by case

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determination must be made as to anticipation”.

The Examiner respectfully disagrees with this argument. First of all, Duecoffre discloses a range which **covers** NOT **overlaps** the claimed range. The claimed range of **0 to 20%** is **within** the Duecoffre’s range of **0 to 40 wt% or 0 to 60 wt%**.

It is held that “anticipation” requires that *every* element of the claims appear in a single reference. Therefore, Duecoffre teaching claimed range anticipates the claims.

Patents are relevant as prior art for all they contain including prior art’s broad disclosure. See MPEP 2123.

It is held that patents are relevant as prior art for all they contain. See *Celeritas Technologies Ltd. v. Rockwell International Corp.*, 150 F.3d 1354, 1361, 47 USPQ2d 1516, 1522-23 (Fed. Cir. 1998) (The court held that the prior art anticipated the claims even though it taught away from the claimed invention. “The fact that a modem with a single carrier data signal is shown to be less than optimal does not vitiate the fact that it is disclosed.”). **NONPREFERRED EMBODIMENTS CONSTITUTE PRIOR ART. Disclosed examples and preferred embodiments do not constitute a teaching away from a broader disclosure or nonpreferred embodiments.** See MPEP 2123. Therefore, Pettus does teach that the process can be used for coating a chrome plated substrate, may be with inferior results than for aluminum substrates. But again, it is expected since according to Applicants “It is well known in the art that chrome surfaces are more difficult to coat than aluminum”.

Conclusion

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Elena Tsoy whose telephone number is 571-272-1429. The examiner can normally be reached on Monday-Thursday, 9:00AM - 7:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Timothy Meeks can be reached on 571-272-142323. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Elena Tsoy
Primary Examiner
Art Unit 1762

ELENA TSOY
PRIMARY EXAMINER



September 29, 2005